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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,336	07/24/2003	Michael X. Yang	007669/P3/CMP/ECP	2292

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EXAMINER

ZHENG, LOIS L

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,336

Applicant(s)

YANG ET AL.

Examiner

Lois Zheng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/14/05, 11/2/05, 1/3/06, 2/8/06, 2/9/06, 2/16/06
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1 and 11 are amended in view of the amendment filed 3 January 2006.
Therefore, claims 1-23 are currently under examination.

Status of Previous Rejections

2. The rejection of claims 1-9 under 35 U.S.C. § 102(b) as being anticipated by Copping et al US 6,251,255 B1(Copping) and evidenced by applicant's admitted prior art is withdrawn in view of the amendment filed on 3 January 2006.

Drawings

3. The drawings were received on 3 January 2006. These drawings are accepted.

Specification

4. The amendments to the specification received on 3 January 2006 are entered.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Yang et al US Patent Application Publication 2004/0016647 A1(Yang).

The teachings of Yang are discussed in paragraph 5 of the previous Non-Final Office Action mailed 30 September 2005. The rejection grounds are maintained for the same reasons as stated in paragraph 5 of the previous Non-Final Office Action.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-9 and 11-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hey et al US Patent Application Publication 2002/0011415 A1(Hey) in view of Copping.

The teachings of Hey in view of Copping are discussed in paragraph 7 of the previous Non-Final Office Action mailed 30 September 2005. The rejection grounds of the instant claims are maintained for the same reasons as stated in paragraph 7 of the previous Non-Final Office Action.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hey in view of Copping and further in view of Genders et al US Patent Application Publication 2002/0189950 A1(Genders) and applicant's admitted prior art.

The teachings of Hey in view of Copping are discussed in paragraph 7 of the previous Non-Final Office Action mailed 30 September 2005. The teachings of Genders and applicant's admitted prior art are discussed in paragraph 8 of the previous Non-

Final Office Action. The rejection ground of the instant claim is maintained for the same reasons as stated in paragraph 8 of the previous Non-Final Office Action.

Response to Arguments

10. Applicant's arguments filed 3 January 2006 have been fully considered but they are not persuasive.

In the remarks, applicant argues that Yang et al. US 2004/0016647 does not qualify as prior art under 35 U.S.C. 102(e) since Yang do not disclose an invention "by another".

Yang does qualify as prior art under 35 U.S.C. 102(e) because Yang and the instant invention have two different inventive entities(i.e. the instant invention has additional inventors). It is well settled that the inventive entity is different if not all inventors are the same. The fact that the application and reference have one or more inventors in common is immaterial. In re Land, 368 F.2d 866, 151 USPQ 621(CCPA 1966). Ex parte DesOrmeaux, 25 USPQ2d 2040(Bd. Pat. App. & Inter. 1992). See MPEP 2136.04[R-1].

Applicant further argues that neither Hey nor Copping discloses both an ionic membrane and a diffuser. In addition, Hey in view of Copping result in the ionic membrane being placed in the anolyte compartment instead of between the anolyte and catholyte compartments.

As discussed in paragraph 7 of the previous Non-Final Office Action mailed 30 September 2005, the anode assembly of Hey in view of Copping includes an anode enclosure ionic membrane. The examiner is taking the position that the solution within

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the anode enclosure is anolyte and the solution outside of the anode enclosure is considered catholyte because the ionic membrane anode enclosure of Hey in view of Copping selectively allow certain ions to pass through. The solution inside the anode enclosure and the solution outside of the anode enclosure contain different materials. Therefore, the ionic membrane anode enclosure of Hey in view of Copping is positioned between the anolyte and the catholyte compartments as claimed. The diffuser plate as taught by Hey in view of Copping is positioned in the catholyte compartment as claimed.

Applicant's further argument based on Gender reference is moot in view of examiner's rebuttal above.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lois Zheng whose telephone number is (571) 272-1248. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LLZ

ROY KING
SUPERVISOR, PATENT EXAMINER
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